

Remarks:

In the March 7, 2007, Office Action, Applicant was advised that should Claim 1 be held to be allowable, Claims 25 and 26 would be objected to under 37 C.F.R. 1.75 as being substantial duplicates of Claim 1. Applicant was advised that should Claim 27 be held to be allowable, Claim 28 would be objected to under 37 C.F.R. 1.75 as being substantial duplicates of Claim 27. Claims 7 and 20 were rejected under 35 U.S.C. Section 112, second paragraph.

On the merits, Claims 1-3, 6, and 8-11 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over the article entitled Bacardi Brings Out the Bottle in Cable-TV Ad for Amaretto --- Spot Is Firm's First to Blatantly Display Product, Vanessa O'Connell, Wall Street Journal (Europe, Brussels, May 2, 2001, page 25 (hereinafter "O'Connell")) in view of the article titled Job-Hunting Web Sites' Ads Will Duel at Super Bowl, Rachel Emma Silverman and Suzanne Vranica, Wall Street Journal (Eastern Edition), New York, NY, January 23, 2001, page B.8 (hereinafter "Silverman et al."), and Official Notice.

Claims 4, 5, and 7 were rejected were rejected under 35 U.S.C. Section 103(a) as being unpatentable over O'Connell in view of Silverman et al. and the printout of a page from Monster.com obtained from the Internet Archive WayBack Machine dated April 18, 2001, at <http://web.archive.org/web/20010418150929/momentum.monster.com/> (hereinafter "Monster.com"), and Official Notice.

Claims 12-26 were rejected were rejected under 35 U.S.C. Section 103(a) as being unpatentable over O'Connell in view of Silverman et al., Lesandrini et al. (U.S. Patent Application Publication No. 2003/0036944), and Official Notice. Claim 27 was rejected under 35 U.S.C. Section 103(a) as being unpatentable over O'Connell in view of Silverman et al., Monster.com, and Official Notice. Claim 28 was rejected under 35 U.S.C. Section 103(a) as being unpatentable over O'Connell in view of Monster.com and Official Notice.

Response Regarding the Notice of "Substantial Duplicates"

The March 7, 2007, Office Action's assertion that Claims 25 and 26 are "substantial duplicates" of Claim 1 is based upon MPEP Section 706.03(k), which states in part that "court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough." Claims 25 and 26 are different in scope from Claim 1, and Claim 27 differs in scope from both Claims 1 and 26. The scope of Claims 27 and 29 are completely different. The March 7, 2007, Office Action seems to have lost sight of the real-world fact that it is desirable, and in many cases essential, to include an array of claims of varying breadth to cover as wide a variety of potential infringer as possible. What may seem to a patent examiner as a small change may well mean the difference between coverage and non-coverage of an infringer, or the difference between a claim surviving a validity challenge and not surviving such a

challenge. This section of the MPEP is there to prevent an applicant from having an unduly large number of independent claims which are relatively indistinguishable in scope. In the present patent application, there are only five independent claims, and they each vary in scope from the others. Accordingly, Applicants respectfully request reconsideration on this issue.

Response Regarding the 35 U.S.C. Section 112, Second Paragraph, Rejections

Applicant has amended both Claim 7 and Claim 20 to clarify them. With regard first to Claim 7, it first requires that a type of printed material having the marketing website logo thereupon is transmitted to consumers. When the consumer is on the website and the website is displaying the list of television networks, Claim 7 requires that a logo or other indicia that identifies the type of printed material also be displayed. As an example, consider a brochure for a car company sent to consumers in conjunction with television advertising in accord with the present invention. The brochure would bear the marketing website logo, and the car company's name would be displayed on the website display of television networks (see Fig. 8).

With regard to Claim 20, Applicant appreciates the Examiner noting the issue, and has added language that was originally inadvertently omitted, thereby clarifying the issue. The process is to allow the consumer to selectively opt for an extra game(s) or contest(s), and, if the consumer has opted for the extra game(s) or contest(s), providing that extra game(s) or contest(s) after completion of the main game or contest. Applicant

appreciates the Examiners thoroughness in identifying this issue, which has not been corrected.

Response Regarding the Use of "Official Notice" in the Rejections

All five of the rejections on the merit are based in part upon "official notice." This is quite simply incorrect, and it is clearly in violation of proper procedure. "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. ... It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. In Re Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ('[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.')." MPEP Section 2144.03. Since all five of the rejections on the merits rely upon such unsupportable Official Notice, all five of the rejections on the merits are improper, and must be withdrawn.

THE PRESENT INVENTION AS CLAIMED

The marketing method of the present invention displays a distinctive logo identifying a particular marketing website during a television commercial. Consumers who have viewed the commercial can log onto the marketing website identified by the

logo and participate in an interactive online game or contest that will increase the consumers' awareness of the advertised product or service and thereby reinforce the offline television advertising seen by them. Once a consumer logs onto the marketing website, the consumer must select the particular enhanced television commercial viewed by the consumer from a series of screens displayed to the consumer on the marketing website. This selection process: 1. displays a list of television networks on which the television commercial has aired, and prompts the consumer to select the particular television network on which the consumer viewed the particular commercial; 2. displays to the consumer a list of television shows broadcasted by the particular television network during which the commercial has been broadcasted, and prompts the consumer to select the particular television show on which the consumer viewed the television commercial; and 3. displays to the consumer a list of television commercials which were broadcasted during the particular television show, and prompts the consumer to select the particular commercial. The marketing website then provides a game or contest for the consumer to play that provides information on or relates to the particular product or service advertised by the particular commercial.

#### THE CITED PRIOR ART

The March 7, 2007, Office Action relies upon four prior art references:

The O'Connell reference – The pertinent portion of the O'Connell reference is brief, and is quoted in its entirety herein:

"Bacardi tried some cable-TV advertising in the U.S. last year with a spot featuring three men going to a party at a hip locale where there were plenty of sexy women. That spot showed the Bacardi icon and directed viewers to a Web site. Paul Francis, a senior marketing manager at Bacardi, says the idea behind the ad was to get consumers to think of Bacardi as hip and cool, and lure them online."

Thus, O'Connell is cited to teach a TV ad with a web address and a website associated with the web address. There is absolutely no indication in the O'Connell reference of what content the website may have had.

The Silverman et al. reference -- The pertinent portion of the Silverman et al. reference is also brief, and is quoted in its entirety herein:

"In the Hotjobs Super Bowl commercial, a silver click-click gravity ball that swings on a string rolls off an employee's desk. As viewers hear the group The Mamas and the Papas singing "Go Where You Want to Go," the ball joins a game of marbles being played in a park. The ad suggests viewers can "control their own destinies and follow their own optimistic dream," Mr. Johnson says. The tagline: "Onward. Upward."

"Hotjobs also has created a video-game version of its commercials that enables users to guide the runaway silver ball through a maze. Users can e-mail the Hotjobs-branded game to friends."

Thus, Silverman et al. is cited to teach a commercial video game that is associated with a TV ad. There is absolutely no indication of where the game comes from, but it is a computer video game that can be e-mailed. No mention whatsoever is made of the website, or of the game itself being on the website. Indeed, the inference is that the game was downloaded, although it could have been provided on a floppy disk or CD-ROM as well.

The Monster.com reference – The Monster.com reference consists of a single page printout (while the March 7, 2007, Office Action references attached pages, only the single page is available via Pair) that appears to be a web page only. There is no indication whatsoever of any printed material in this reference. While the website does indeed bear the Monster.com logo, it most certainly is not a printed material, and thus the Monster.com reference clearly does not teach in any way what the March 7, 2007, Office Action indicates that it teaches.

The Lesandrini et al. reference -- The pertinent portion of the Lesandrini et al. reference is also brief, and is quoted in its entirety herein:

"[0137] Online Games

"[0138] The site will feature a number of online games, bringing in elements from the commercials that are on the site. These games will also earn users points and will prompt users to view commercials to complete various games. For example, one game may be a "where are they now?" trivia game, in reference to popular characters in advertisements. AS mentioned before, another example is illustrated in FIG. 12, called Mascot Mania. Participants are asked to select the correct name of the mascot, the brand, the company, and the type of product it represents."

Fig. 12 "is an illustration of a game." Page 3, paragraph 0053, from the Brief Description of the Drawing[s]." The Lesandrini et al. reference apparently allows one to choose between a number of different games. The Lesandrini et al. reference is also cited as teaching determining whether a consumer has previously registered (which is apparently a reference to the member log in displayed in Fig. 7).

THE CITED PRIOR ART DOES NOT TEACH THE  
ELEMENTS OF THE INVENTION AS CLAIMED

Each and every one of the rejections are characterized by one overwhelming defect – the all rely on "Official Notice" to supply the vast portion of the claims that no prior art was identified to teach. As such, these rejections are both nonstatutory and deficient and utterly fail to present *prima facie* obviousness rejections. As mentioned above, the reliance on "Official Notice" is stated to be unacceptable in MPEP Section 2144.03. It has also been overwhelmingly rejected by the Court of Appeals for the Federal Circuit in In Re Zurko: "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. ... It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." 258 F.3d at 1385, 59 USPQ2d at 1697.

Claim 1 – The O'Connell reference is cited as teaching the first two steps of Claim 1, and the Silverman et al. reference is cited as teaching the last step. The Silverman et al. reference contains nothing that indicates that the "game or contest provides information on or relates to the particular product or service advertised by the particular enhanced television commercial," a limitation contained in the last step of Claim 1. All that the Silverman et al. reference teaches is a video game that "enables users to guide the



runaway silver ball through a maze." Accordingly, the Silverman et al. reference fails to teach this step of Claim 1.

The other three steps of Claim 1, which together constitute well over half of Claim 1, are not taught by any cited prior art, but rather by the invalid "Official Notice." Specifically, nothing in cited prior art teaches the following steps:

1. "displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a list of television networks on which enhanced television commercials have aired, and prompting the consumer to select the particular television network on which the consumer viewed the particular enhanced television commercial;"
2. "displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows enhanced television commercials have been broadcasted, and prompting the consumer to select the particular television show during which the consumer viewed the particular enhanced television commercial;" and
3. "displaying to the consumer a list of enhanced television commercials which were broadcasted during the particular television show, and prompting the consumer to select the particular enhanced television commercial."

The position of the March 7, 2007, Office Action is that all of this is obvious in view of the incorrect application of "Official Notice" to teach what the prior art does not

teach. The implicit admission in the failure of the March 7, 2007, Office Action to cite any prior art is no prior art applicable to these limitations was located. Applicant believes that there is no relevant prior art because his invention is innovative and that no one has ever contemplated it prior to its invention by Applicant.

This three-step process trivialized by the March 7, 2007, Office Action's characterization of it is highly specific and nonobvious. In actuality, each of the three steps inherently contains two steps (namely a displaying step and a prompting step), so there are actually no less than six steps for which no prior art has been cited. Claim 1 requires first that the marketing website display a list of television networks upon which enhanced commercials have appeared. No prior art is cited to show this step. Claim 1 requires next that the consumer be prompted to select upon which of the displayed television networks the consumer saw the enhanced commercial. Again, no prior art is cited to show this step.

Claim 1 then requires that the marketing website display a list of television shows on the selected television network upon which enhanced commercials have appeared. Once again, no prior art is cited to show this step. Claim 1 next requires that the consumer be prompted to select upon which of the displayed television shows the consumer saw the enhanced commercial. Yet again, no prior art is cited to show this step. Claim 1 then requires that the marketing website display a list of enhanced commercials that have appeared on the selected television show. Still again, no prior art

is cited to show this step. Claim 1 at this point requires that the consumer be prompted to select upon which of the enhanced commercials the consumer saw on the selected television show. And again, for the sixth time, no prior art is cited to show this step.

The March 7, 2007, Office Action in its discussion of Claims 6 and 8-10 mentions in passing (but does not rely upon in any rejection) U.S. Patent No. 5,940,073, to Klosterman et al. Applicant has briefly reviewed the Klosterman et al. patent, which teaches an on-screen television program guide and is completely unrelated to television commercials displayed during a television program. Further, nothing in the Klosterman et al. patent teaches or suggests the six limitations of the three steps specifically referenced above.

Claim 1 is thus not taught by the cited prior art, and the use of "Official Notice" is incorrect and clearly in violation of proper procedure. Thus, Claim 1 is believed to be patentable, and its allowance is respectfully submitted. While dependent Claims 2-24 all add additional limitations which are not taught by the cited prior art, it is believed to be unnecessary to discuss them herein since these claims are all also allowable as depending from Claim 1, which is, as indicated above, believed to be allowable for the reasons stated. Accordingly, the allowance of Claims 2-24 is also respectfully submitted.

Claims 25 and 26 -- The O'Connell reference is cited as teaching the first two steps of Claim 1, and the Silverman et al. reference is cited as teaching the last step. As mentioned above with reference to the discussion of Claim 1, the Silverman et al.

reference contains nothing that indicates that the "game or contest provides information on or relates to the particular product or service advertised by the particular enhanced television commercial," a limitation contained in the last steps of Claims 25 and 26. The other three steps, which together constitute well over half of Claim 1, are not taught by any cited prior art, but rather by the invalid "Official Notice." Specifically, nothing in cited prior art teaches the following steps:

1. "displaying to a consumer who has entered said marketing website in response to viewing the television commercial a list of television networks on which television commercials which display said marketing website logo have been broadcasted, and prompting the consumer to select the television network on which the consumer viewed the television commercial;"
2. "in response to the consumer's selection of a particular television network, displaying to the consumer a list of television shows broadcasted by the particular television network during which television shows television commercials which display said marketing website logo have been broadcasted, and prompting the consumer to select the television show during which the consumer viewed the television commercial;" and
3. "in response to the consumer's selection of a particular television show, displaying to the consumer a list of television commercials which display said marketing

website logo and which were broadcasted during the selected television show, and prompting the consumer to select the television commercial."

This three-step process is highly specific and nonobvious, with each of the three steps inherently containing two steps (a displaying step and a prompting step). Accordingly, so there are actually no less than six steps for which no prior art has been cited. Claim 25 requires first that the marketing website display a list of television networks upon which enhanced commercials have appeared. No prior art is cited to show this step. Claim 25 requires next that the consumer be prompted to select upon which of the displayed television networks the consumer saw the enhanced commercial. Again, no prior art is cited to show this step.

Claim 25 then requires that the marketing website display a list of television shows on the selected television network upon which enhanced commercials have appeared. Once again, no prior art is cited to show this step. Claim 25 next requires that the consumer be prompted to select upon which of the displayed television shows the consumer saw the enhanced commercial. Yet again, no prior art is cited to show this step. Claim 25 then requires that the marketing website display a list of enhanced commercials that have appeared on the selected television show. Still again, no prior art is cited to show this step. Claim 25 at this point requires that the consumer be prompted to select upon which of the enhanced commercials the consumer saw on the selected television show. And again, for the sixth time, no prior art is cited to show this step.

Claim 25 is thus not taught by the cited prior art, and the use of "Official Notice" is incorrect and clearly in violation of proper procedure. Thus, Claim 25 is believed to be patentable, and its allowance is respectfully submitted.

With respect to Claim 26, while the language in Claim 26 used to describe the three steps (in actuality six steps) varies somewhat from that used in Claim 25, virtually the same limitations are present, and the arguments with regard to these six steps with regard to Claim 26 is hereby incorporated by reference with regard to Claim 26 as well. Claim 26 also includes an additional limitation that is not included in Claim 25, namely that game that is provided allows a consumer to play for a prize or award. No prior art is cited to teach this limitation other than the statement in the March 7, 2007, Office Action that it would be obvious to do so. The statement that a limitation taught by the claims is obvious because it is obvious is circuitous logic at best, and is clearly a violation of the requirements of relying upon rejections rather than nebulous statements and opinions that are wholly unsupported by the prior art.

Claim 26 is thus not taught by the cited prior art, and the use of "Official Notice" is incorrect and clearly in violation of proper procedure. Thus, Claim 26 is believed to be patentable, and its allowance is respectfully submitted.

Claim 27 -- The O'Connell reference is cited as teaching the first two steps of Claim 27, and the Silverman et al. reference is cited as teaching the last step. The Silverman et al. reference contains nothing that teaches "providing incentives to motivate

customers to enter the marketing website" of "providing marketing information . . . in a manner which is associated with said incentives." All that the Silverman et al. reference teaches is a video game that "enables users to guide the runaway silver ball through a maze." The March 7, 2007, Office Action asserts that the game provided by the Silverman et al. reference "is an incentive to get a user to access a website." That may be so, but is readily apparent that the term "incentives" as used in Claim 27 is used in an utterly different context than as the word is used in the rejection of the March 7, 2007, Office Action. Applicant can be his own lexicographer, and the specification of the present patent application clearly teaches what an incentive is. Accordingly, the Silverman et al. reference fails to teach this step of Claim 27.

A step of Claim 27 that is not taught by any cited prior art, but rather by the invalid "Official Notice," is the following: "displaying to a consumer who has entered said marketing website in response to viewing a particular enhanced television commercial a series of screens which prompt the consumer to select the particular enhanced television commercial viewed by the consumer." No prior art is cited to show this step. Claim 27 is thus not taught by the cited prior art, and the use of "Official Notice" is incorrect and clearly in violation of proper procedure. Thus, Claim 27 is believed to be patentable, and its allowance is respectfully submitted.

Claim 28 -- The O'Connell reference is cited as teaching the first two steps of Claim 28, and the Monster.com reference is cited as teaching the last step. The

Monster.com reference contains nothing that teaches " providing marketing information relating to the product advertised by the particular enhanced television commercial in a manner which the consumer finds gratifying." In fact, the one page Monster.com reference teaches nothing of relevance to this step at all. Monster.com has nothing to do with products, but rather is a hiring management tool. Accordingly, the Monster.com reference fails to teach this step of Claim 28.

The other three steps of Claim 8, which together constitute well over half of Claim 28, are not taught by any cited prior art, but rather by the invalid "Official Notice." Specifically, nothing in cited prior art teaches the following steps:

1. "allowing a consumer entering said marketing website to select the particular television network on which the consumer viewed a particular one of said plurality of television commercials;"
2. "allowing the consumer to select the particular television show during which the consumer viewed said particular television commercial;" and
3. "allowing the consumer to select said particular television commercial."

This three-step process trivialized by the March 7, 2007, Office Action's characterization of it is highly specific and nonobvious. Claim 28 first requires that a consumer entering said marketing website be allowed to select the television network on which the consumer viewed a particular one of the television commercials. No prior art is cited to show this step. Claim 28 next requires that the consumer be allowed to select



the television show during which the consumer viewed the particular television commercial. Again, no prior art is cited to show this step. Claim 28 then requires that the consumer be allowed to select the particular television commercial. Once again, no prior art is cited to show this step. Claim 28 is thus not taught by the cited prior art, and the use of "Official Notice" is incorrect and clearly in violation of proper procedure. Thus, Claim 28 is believed to be patentable, and its allowance is respectfully submitted.

Accordingly, Applicants believe that Claims 1-28 are patentable at this time. These claims remain pending following entry of this Amendment A, and are in condition for allowance at this time. As such, Applicants respectfully request entry of the present Amendment A and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the

application could be expedited, the Examiner is requested to call Applicants' undersigned attorney at the number listed below.

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